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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,006	02/19/2004	Eick Niemeyer	594-35587-USCP	4322
44871	7590	10/18/2007		
MADAN, MOSSMAN & SRIRAM, P.C. 2603 AUGUSTA DRIVE SUITE 700 HOUSTON, TX 77057-5662			EXAMINER FITZGERALD, JOHN P	
			ART UNIT 2856	PAPER NUMBER
			MAIL DATE 10/18/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/782,006

Applicant(s)

NIEMEYER ET AL.

Examiner

John Fitzgerald

Art Unit

2856

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13,15-28,30-43 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5,8-13,15-28,30-43 and 45 is/are allowed.
- 6) ☒ Claim(s) 6 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, see page 14, filed 30 August 2007, with respect to independent claims 1, 15, 16, 21, 27, 30, 31, 36, 42, 45 and all of their dependents have been fully considered and are persuasive. The rejection of these claims has been withdrawn.
2. As to independent claim 6 and its dependent 7, the Hill et al. reference applies to all the limitations recited, since it does not recite the limitations of increasing the draw rate "continuously" or in a "step-wise" manner as recited in the independent claims indicated allowable above.

### ***Claim Rejections - 35 USC § 103***

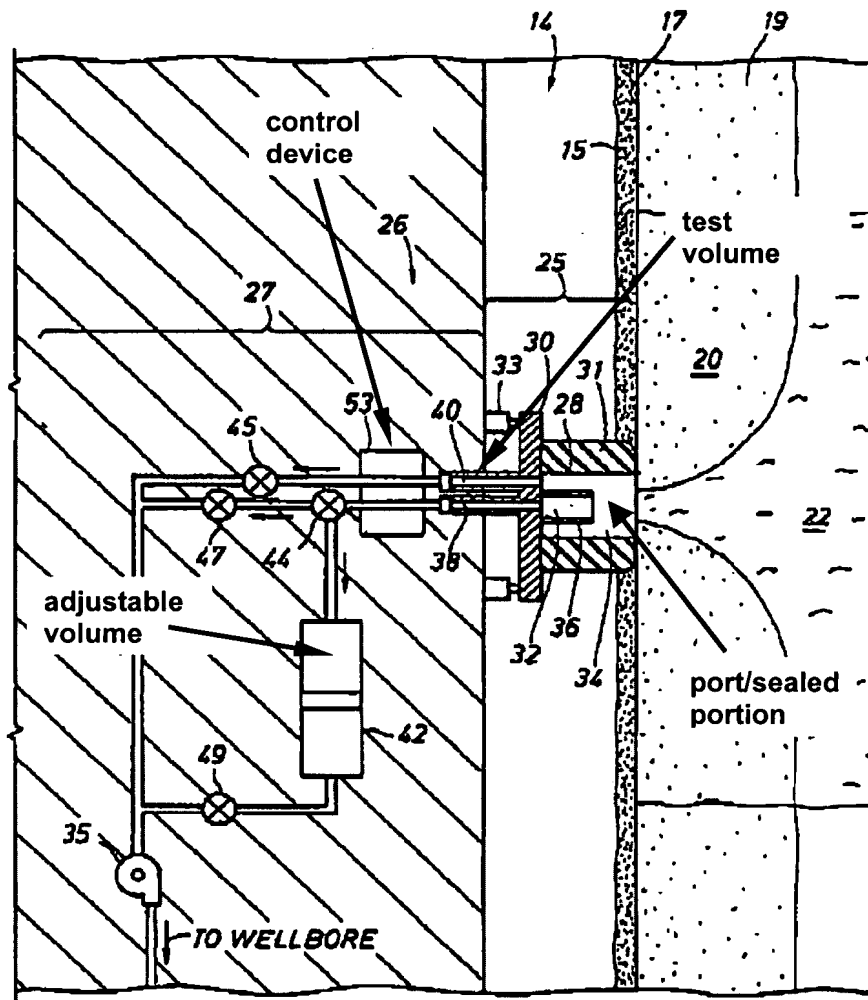
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,964,301 to Hill et al. Hill et al. disclose a method and apparatus for determining in situ a desired formation parameter of interest (see Fig. 5 below) including all of the recited elements of the claims of a conveyable tool into a well borehole (as recited in claim 6) (Hill et al.: col. 6, lines 7-20); a test unit (27) in the tool with a probe/port in fluid communication with the formation via packers or seals including a test volume (38, 40) coupled with a piston with a variable volume (42) (note: Although Hill et al. do not specifically disclose the variable volume (i.e. piston-cylinder) as a 'test' volume, that is, measuring and/or testing occurring within the 'test' volume, it would have been obvious to one having ordinary skill in the art at the time the

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invention was made to combine the measurement/testing elements within the 'test' for it consists of a simple matter of rearrangement of elements, and it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70 (CCPA 1950).

Furthermore, Applicant hasn't stated a particular reason as to why any measurement/testing capabilities must be located in any particular location, thus it is not considered a critical feature of the instant invention, and as such, the apparatus/method disclosed by Hill et al. appears to function equally as well with separate variable volume and measurement/testing means); a control/sensing device (53) for monitoring/determining at least one characteristic of the test volume (i.e. formation fluid parameters, e.g. contamination/composition, pressure, temperature (Hill et al.: col. 11, lines 6-13); wherein the draw rate of the fluid into the test volume is controlled by the control device, capable of adjusting/altering the draw rate based on a measured/determined formation fluid characteristic (note, that includes increasing or decreasing during one or more of a first or second draw portion, as recited in claim 6) (Hill et al.: col. 9, lines 1-53); the control device includes a variable rate pump (35); and a processor and controller following programmed instructions for control of the apparatus.

**FIG. 5** Hill et al.



*Allowable Subject Matter*

5. Claims 1-5, 8-13, 15-28, 30-43 and 45 are allowed over the Prior Art of record.
6. The following is a statement of reasons for the indication of allowable subject matter:  
The reasons for indicating allowable subject matter is the inclusion of the limitations of increasing the draw rate "continuously" or in a "step-wise" manner.

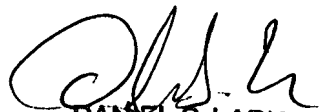
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***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Fitzgerald whose telephone number is (571) 272-2843. The examiner can normally be reached on Monday-Friday from 7:00 AM to 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron Williams, can be reached on (571) 272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JF  
10/15/2007



DANIEL S. LARKIN  
PRIMARY EXAMINER